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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/083,122	05/22/98	MAJEED	PO002-0009

HM32/1123
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EXAMINER
TAYLOR, T

ART UNIT 1621 PAPER NUMBER

DATE MAILED:

11/23/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/083,122

Applicant(s)

Majeed et al

Examiner

TAYLOR VICTOR OH

Group Art Unit

1621



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5 recites the broad recitation, and the claim also recites which is the narrower statement of the limitation. The claim line 13, "e.g. *Garcinia cambogia* fruit", is recited after a broader claim of "natural sources".

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Claim Rejections - 35 USC § 103

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowenstein (U.S. 3,764,692) in view of Moffett et al (U.S. 5,656,314). Lowenstein teaches that the

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potassium salt of hydroxy citric acid (see col. 2, lines 1-4) may be obtained from the garcinia acid lactone by base hydrolysis with potassium hydroxide (see col.1, lines 35-39)and the compound can be made up in the form of conventional pharmaceutical preparations with therapeutically active materials in solid forms or liquid forms (see col. 2, lines 27-46). Furthermore, Lowenstein discloses that the garcinia acid is a strong inhibitor of citrate cleavage enzyme (see col.3, lines 31-32). The instant claims differ from Lowenstein in that the instant invention claims that the processing steps involve extraction (3 times) at pH 10, reflux, filtration, washing, milling, packing, and that the compound made by the process contains 33 to 38% of elemental potassium, has a specific rotation from $(-)$ 20° to $(-)$ 23° , and can be stable for 5 years under normal storage conditions. However, Lowenstein has laid down the fundamental concept as well as procedures for obtaining the compound from the Garcinia fruit. Moreover, Moffett et al teaches that the process for obtaining the hydroxycitric acid concentrate from the fruit rind of the Garcinia genus is basically begun with extracting Garcinia rind with a water miscible organic solvent(e.g., acetone or ethyl alcohol)(see col.1, lines 57-58) and as a result of the process, about 35 to 55%(see col. 1, a line 37), the free hydroxycitric acid is obtained. The percentage of elemental potassium, the specific rotation of the compound, and the long stability of the compound are naturally obtained as unique characteristics for evaluating the compound, not as the novelty of the invention. Therefore, it would have been obvious by the one with an ordinary skill in the art to have combined the references so as to optimize the product in the process.

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baniel et al. (U.S. 4,275,234) discloses a process for the extraction of acids from aqueous solutions, comprising an extraction operation in which a water-immiscible organic extractant consisting of at least one secondary or tertiary amine, in which the number of carbon atoms is at least 20, or a mixture of two or more such amines, dissolved in a water-immiscible organic solvent, is mixed with the aqueous solution of the acid, the organic extract is removed from the residual aqueous liquid and, at a higher temperature than the temperature at which the extraction is performed, subjected to a stripping operation with an aqueous liquid for back-extracting at least a considerable amount of the acid from the organic extract into the water and isolating substantially all the amine in the organic phase; the aqueous back-extract is separated from the organic phase.

Guthrie et al (U.S. 3,767,678) describes the preparation of making ester and amide derivatives of threo-hydroxycitric acid γ -lactone by using an anhydrating agent defined as an agent that serves to convert a cis-1,2-dicarboxylic acid to the corresponding anhydride. Suitable anhydrating agents includes alkanolic acid anhydrides, such as acetic anhydride, propionic anhydride; and alkanoyl halides, for example acetyl chloride. The anhydration reaction is suitably carried out at an elevated temperature in the range of 50° to 150° C.

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Guthrie et al (U.S. 3,810,931) discloses the preparation of epoxyaconitic acid and esters useful for the control of lipogenesis. Epoxyaconitic acid may be prepared by epoxidation of aconitic acid. The epoxidizing agents include hydrogen peroxide and peracids like persulfuric acid. The epoxidation is preferably carried out in an organic solvent such as an alcohol or ether in the presence of an alkali metal salt at the temperature in the range of 0° to 100° C.

Ravi et al (FR 96-13094) describes a method of making magnesium(-)-hydroxycitrate useful in dietetics and in the cardiovascular field. Magnesium(-)-hydroxycitrate is prepared from the reaction of the extract of *Garcinia cambogia* with ethyl alcohol in the presence of poly(vinylpyrrolidone). The crude product is filtered, agitated with an anion exchange resin and the final product is isolated after being dried.

Lawhon et al (U.S. 4,643,902) discloses a process of producing food juices by employing ultrafiltration. During the process, the UF retentate is treated to inactivate a sufficient number of spoilage microorganisms to inhibit spoilage of the juice under storage conditions, whereas the UF permeate can be treated by reverse osmosis to concentrate the flavor and aroma components. The concentrated flavor and aroma components can be recombined with the UF retentate for the other uses. The acid content of juice can be reduced by passing a portion of the RO retentate through an ion-exchange column.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Victor Oh whose telephone number is (703) 305-0809. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

TV Oh
11/23/98


GARY GEIST
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